

Commissioner for Patents
Page 11

Serial No.: 09/527,584

REMARKS/ARGUMENTS*Claim Rejections*

In the Office Action of 16 March 2004, the Examiner rejected claims 1-30 under 35 U.S.C. § 102(e) as being anticipated by United States Patent 6,363,319 (Hsu).

Applicant respectfully traverses the s. 102 rejection over Hsu. Although the applicant disagrees that claims 1-30 as they currently read are anticipated by Hsu, and that therefore no amendment is necessary, the applicant has amended main claims 1 and 15 to advance prosecution with a view to allowance.

Despite these amendments, the applicant respectfully submits that the s. 102 rejection of claims 1 to 30 is wholly improper for the following reasons. The law of anticipation is clear that in order for an anticipation rejection to be valid, the cited prior art must teach all of the limitations of the rejected claim. As stated in MPEP 2131, "A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applying these principles of law to the invention described and claimed in the present application, it is respectfully submitted that Hsu does not teach both a) determining a resource requirement of the connection-oriented traffic and b) *dynamically adjusting a respective connectionless traffic metric based on the determined resource requirement of the connection-oriented traffic*. Therefore, the s. 102 rejection is improper and hereby traversed.

Telephone Interview

On July 8, 2004, a telephone interview was conducted with the Examiner to discuss patentable distinctions of the claimed invention over Hsu, the Examiner seemed to agree that elements in the body of the claim, e.g. features a) and b) of main claim 1,

Commissioner for Patents
Page 12

Serial No.: 09/527,584

distinguished over Hsu and amendments to the body of the claim were not required to overcome the s.102 rejection. Instead, he suggested that amendment to the preamble of the claim would be required to overcome the s.102 rejection. For example, for claim 1, the Examiner indicated that, in his view, the expression "managing a logical allocation of resources between connection-oriented traffic and connectionless traffic" creates "too large of a footprint." The Examiner, however, suggested that he would be amenable to allowing the claims if the applicant amended the preamble of each of the main claims. For claim 1, the Examiner suggested amending the preamble to specify that the method *manages a logical allocation of resources for connectionless traffic based on a resource requirement for connection-oriented traffic*. The applicant thanks the Examiner for discussion and suggestions made during the interview. After giving careful consideration to the Examiner's suggestion for amendment of the preamble of the claims, the applicant has instead amended the body of main claims 1 and 15.

The applicant respectfully submits that amendment of the preamble would not be appropriate. The applicant respectfully submits that the claim, when read as a whole, patentably distinguishes over Hsu. As stated in MPEP 2111.02, "The claim preamble must be read in the context of the entire claim." It is respectfully submitted that no amendment to the preamble is warranted where the claim, as a whole, patentably distinguishes over the prior art. It is submitted that it is the purpose of the body of the claim to recite limitations that distinguish over the prior art. It is the combination of features a) and b) defined in claim 1 that define the invention patentably over Hsu and provide for managing a logical allocation of resources between connection-oriented traffic and connectionless traffic defined in the existing preamble, and as such, the Applicant believes these features a) and b) which distinguish over the cited art are properly defined in the body of the claim. Therefore, it is respectfully submitted that a requirement for amendment of the preamble as suggested by the Examiner to overcome the s. 102 rejection over Hsu is improper and not required. Notwithstanding this and the applicant's traversal of the s. 102 rejection, the applicant has amended main claims 1 and 15 as set forth in the paragraph below. The applicant believes that these amendments fully address the Examiner's concerns as were conveyed during the interview.

Commissioner for Patents
Page 13

Serial No.: 09/527,584

Claim Amendments

The applicant has amended the body of main claims 1 and 15 to specify that the method and shared network element are *thereby providing a logical allocation of resources for connectionless traffic based on a resource requirement of connection-oriented traffic.* It is respectfully submitted that this amendment addresses the concerns articulated by the Examiner during the interview.

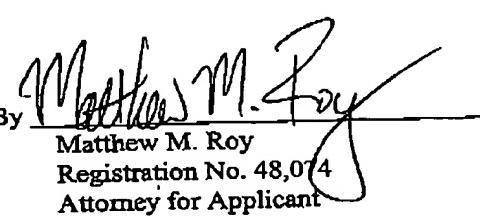
Conclusion

In light of the amendments to independent claims 1 and 15 and in view of the arguments set out above, withdrawal of the s. 102 rejection of claims 1 to 30 and reconsideration of the present application with a view to allowance is respectfully requested.

Respectfully submitted,

PETER J. ASHWOOD SMITH

By



Matthew M. Roy
Registration No. 48,074
Attorney for Applicant

MMR/sw

Address:
1981 McGill College Avenue, Suite 1600
Montreal, Quebec, Canada H3A 2Y3